No. 14935.

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

LAURENCE MASSA,

Appellant,

vs.

JIFFY PRODUCTS CO., INC.,

Appellee.

Appeal From the United States District Court for the Southern District of California, Central Division.

PETITION FOR REHEARING.

JOSEPH W. FAIRFIELD and
ETHELYN F. BLACK,
6505 Wilshire Boulevard,
Los Angeles 48, California,
Attorneys for Appellant.

Parker & Son, Inc., Law Printers, Los Angeles. Phone MA. 6-9171.

TABLE OF AUTHORITIES CITED

Cases

Statutes

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To the Honorable, Albert Lee Stephens, William E. Orr, Circuit Judges, and John R. Ross, District Judge:

The appellant above-named respectfully petitions this Honorable Court for a rehearing of the appeal in the above-entitled cause, and in support of this petition represent to the Court as follows:

We reserve our argued position as to each of the points of appeal, but in this petition address ourselves solely to that feature of the decision wherein we believe the Court may be convinced its result is based upon the application of incorrect legal principles.

Therefore this petition is devoted to convincing this Court that it has erred in its determination on four major questions put to it upon appeal.

1. On pages 2 and 3 of the printed opinion, the Court concluded that since Jiffy asked for a determination of the patent's validity in its counterclaim against Jetco, coupled with Jetco's admission of ownership of the patent, the case at bar is distinguishable from the case of *Brody v. Chas. F. Hubbs & Co.* (S. D. N. Y., 1951), 11 F. R. D. 337. In making this distinction the Court is overlooking that the *Brody* case held in effect that the question of the validity of a patent is not a necessary issue to be determined in an action for unfair competition. Thus, regardless, of whether the ownership of the patent was in Laurence Massa or in Jetco, the determination of its validity was not germane to the action for unfair competition and trade-mark infringement commenced by Jetco.

2. If Laurence Massa is really a necessary and indispensable party to the proceedings so that a complete determination of all issues may be had among all parties, it was still error to enter a default judgment adjudicating the rights to the trade-mark without the plaintiff, Jetco, participating therein. Since Jetco's action is for unfair competition in that defendant Jiffy was using the same mark as plaintiff Jetco on a similar product, plaintiff Jetco has a substantial interest in determining the ownership of the trade-mark. The default judgment barred it from participating in that phase of the trial: Jetco could offer no evidence to the contrary and could not cross-examine any

witnesses. Now by the entry of this default judgment Jetco is forever barred from participating in the determination of a vital issue to its case against Jiffy.

3. On pages 5-6 of its Opinion this Court has attempted to distinguish the case of *Klapprott v. United States,* 335 U. S. 601, from the case at bar by holding that a heavier burden is placed upon the government in a denaturalization proceeding than in a patent case which contains no sancity equivalent to the right of citizenship. In coming to this conclusion it is respectfully submitted by your petitioner that this Court has overlooked the fact that *both* cases require evidence that must be clear, unequivocal and convincing, rising to the dignity of perhaps *beyond a reasonable doubt. Bradley v. Great Atlantic and Pacific Tea Co.,* 78 Fed. Supp. 388, 390-391, reversed on other grounds, 340 U. S. 147, 91 S. Ct. 127, 95 L. Ed. 118; rehearing denied 340 U. S. 918; 71 S. Ct. 349; 95 L. Ed. 663; *Klapprott v. United States,* 335 U. S. 601, 612.)

In the *Bradley* case the Court also emphasized that the presumption of validity is so great that it may not be destroyed by evidence recognized as sufficient in a civil case (p. 390). It is, therefore, respectfully submitted that even accepting as true all well pleaded averments in a verified complaint, although probably recognized as sufficient evidence in a civil case, it is still insufficient to overcome the presumption of the validity of a patent.

4. The Court on pages 6-7 of its printed opinion held that 15 U. S. C. A. 1119 has overruled the principle of

law enunciated in *Drittel v. Friedman* (2d Cir., 1946), 154 F. 2d 653.

The *Drittel* case was based on 15 U. S. C. A. 102, which read as follows:

> "That whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the cause of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation."

United States Code Annotated, Title 15, Section 1064, now in effect, reads in part as follows:

> "§1064. Cancellation of registration. Any person who believes that he is or will be damaged by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905, may upon the payment of the prescribed fee, apply to cancel said registration . . .
>
> (a) within five years from the date of the registration of the mark under this chapter; or . . ."

Section 46a of the Act of July 5, 1946 (historical note following 15 U. S. C. A. 1051) provides in part as follows:

> "That the repeal of all inconsistent Acts 'shall not affect the validity of registrations granted or applied

for under any of said Acts prior to the effective date of this Act (July 5, 1947), or rights or remedies thereunder except as provided in sections 8, 12, 14, 15 and 47 of this Act (sections 1058, 1062, 1064, 1065, and note to this section of this title).' "

The *Drittel* case refers to procedure, namely, that parties seeking title or ownership to a trade-mark must first make its application to the Commissioner of Patents. It is respectfully submitted that 15 U. S. C. A. 1119 is not so radically different from its former 15 U. S. C. A. 102, as to amount to an overruling of the procedural requirements set forth in the *Drittel* case, particularly if read in conjunction with 15 U. S. C. A. 1064. The latter section is especially important since it requires an aggrieved individual to apply for cancellation of the registration within five years from the date of the registration of the mark as a prerequisite.

For the foregoing reasons it is respectfully requested that this petition for a rehearing should be granted.

Respectfully submitted,

JOSEPH W. FAIRFIELD and
ETHELYN F. BLACK,
Attorneys for Appellant.

State of California, County of Los Angeles—ss.

JOSEPH W. FAIRFIELD, being first duly sworn, on oath certifies and says:

That he is one of the attorneys for appellant in this cause; that he makes this Certificate in compliance with Rule 23 of the rules of this Court; that in his judgment the within and aforegoing Petition for Rehearing is well founded and is not interposed for delay.

JOSEPH W. FAIRFIELD

Subscribed and sworn to before me at Los Angeles, California, this 15th day of February, 1957.

ETHELYN F. BLACK

Notary Public in and for the State of California, County of Los Angeles.